

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., and SAMSUNG SEMICONDUCTOR, INC.,
Petitioner,

v.

TESSERA ADVANCED TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2018-00466
Patent 6,784,557 B2

Before TREVOR M. JEFFERSON, JOHN A. EVANS, and
CARL M. DEFRANCO, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

On December 13, 2018, the parties filed a joint motion to terminate this proceeding under 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 20. The parties also filed a copy of their Settlement and License Agreement (Ex. 2015) and associated Consent Letter (Ex. 2016). In a joint request, the parties identified the settlement agreement and consent letter as confidential business information and requested they be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 21. For the reasons set forth below, we grant both the joint motion to terminate and the joint request to treat the settlement agreement and consent letter as business confidential information.

The parties indicate in their joint motion that termination is appropriate because they have resolved all their disputes relating to U.S. Patent No. 6,784,557 B2 (“the ’557 patent”). Paper 20, 1–2. Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In this proceeding, the parties have not completed briefing, and we have not had an oral hearing or issued a final written decision. See Paper 20, 1. In addition, besides this proceeding, the ’557 patent was the subject of three separate matters,¹ which the parties represent have been “terminated” or they have “stipulated to dismiss with prejudice.” *Id.* at 1–2. Under these circumstances, we determine it is appropriate to terminate this proceeding without rendering a final written decision. See 37 C.F.R. §§ 42.72. We determine also that the parties have complied with the requirements of 37 C.F.R. § 42.74(c), and, therefore, we grant

¹ The related matters include a proceeding before the U.S. International Trade Commission, an action in the U.S. District Court for the District of New Jersey, and a proceeding in the International Court of Arbitration. Paper 20, 1–2.

the parties' joint request to treat the settlement agreement and consent letter as business confidential information to be kept separate from the patent file.

In consideration of the foregoing, it is hereby:

ORDERED that the parties' joint motion to terminate this proceeding is *granted*;

FURTHER ORDERED that, as to all parties, this proceeding is *terminated*; and

FURTHER ORDERED that the parties' joint request that the Settlement and License Agreement (Ex.1015) and Consent Letter (Ex. 2016) be treated as business confidential information to be kept separate from the patent file and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*.

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Patent 6,784,557 B2

For PETITIONER:

John Kappos
Brian Berliner
Ryan Yagura
Nicholas Whilt
Xin-Yi Zhou
O'MELVENY & MYERS LLP
jkappos@omm.com
bberliner@omm.com
ryagura@omm.com
nwhilt@omm.com
vzhou@omm.com

For PATENT OWNER:

Matthew Moore
Robert Steinberg
Charles Sanders
Jonathan Strang
LATHAM & WATKINS LLP
matthew.moore@lw.com
bob.steinberg@lw.com
charles.sanders@lw.com
jonathan.strang@lw.com